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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,177	06/19/2001	Akira Usami	1774-0109P	9891
2292	7590	09/23/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			NGUYEN, THU HA T	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,177

Applicant(s)

USAMI, AKIRA

Examiner

Thu Ha T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims **1-7** are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant is unclear to point out "the terminal" in the inquiring from the e-mail delivery apparatus step and sending the information step of 2nd and 3rd paragraphs of claim 7. For purpose of examination, examiner assumes that applicant means "the terminal" as "the mail destination".

5. Claim 1 recites the limitation "the mail destination" in lines 5 and 12-13, "the information" in lines 13-14, 16-17 and 18. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 7 recites the limitation "the information" in lines 11 and 14. There is insufficient antecedent basis for this limitation in the claim.

7. Appropriate correction is required.

Claim Rejections - 35 USC § 103

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-2 and 6-7 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Kambayashi et al.** (hereinafter Kambayahsi) U.S. Publication No. **US 2001/0004261**, in view of **Fujisawa et al.** (hereinafter Fujisawa) JPO Publication No. **10-303972**.

10. As to claim 1, Kambayashi teaches the invention substantially as claimed, including an e-mail delivery apparatus comprising:

a receiving means for receiving e-mail and transmission time information designating a time the e-mail is to be sent to the mail destination (figures 1, 2, block S5, paragraphs 0020, 0050, 0066);

a transmission means for reading e-mail based on the transmission time information and sending information in accordance with the read e-mail to the mail destination (figures 1, 2, block S6, paragraphs 0050-0051);

wherein said transmission means inquires at the mail destination whether information in accordance with or not it desires to receive the e-mail before the time designated by the transmission time information and, when receiving a response that it

desires to receive the information in accordance with the e-mail from the mail destination e-mail to the mail sends the information in accordance with the destination (paragraphs 0020, 0050-0051).

Even though Kambayashi does not explicitly teach a memory means for storing the received e-mail and the transmission time information; however, Kambayashi teaches a sender sends e-mail message to server A1, then server A1 sends e-mail message to server A2 of the receiving client side (figure 1, paragraph 0051). Therefore, this feature deems to be obvious to one of ordinary skill in the art that in every e-mail server should obviously have a memory in order to keep a received e-mail from sender, process the e-mail and send the e-mail to recipient. Therefore, it would have been obvious to one skill in the art at the time the invention was made to have a memory to store e-mail because it would provide an efficient communication system that having memory to store e-mail in order to provide it to recipient.

Moreover, in order to support the obviousness of memory means for storing the received e-mail step, Fujisawa teaches a memory means for storing the received e-mail and the transmission time information (abstract). It would have been obvious to one of ordinary skill in the art to modify the process of Kambayashi to include a memory means for storing the received e-mail process of Fujisawa because it would provide an efficient communications system that having memory to store and process the e-mail in order to provide it to the specified recipient.

11. As to claim 2, Kambayashi teaches the invention substantially as claimed, wherein said receiving means inquires to a transmitter of said e-mail about a time for sending said e-mail when receiving said e-mail and receives said transmission time information in accordance with the inquiry (figures 1, 2, block S6, paragraphs 0050-0051).

12. As to claim 6, Kambayashi teaches the invention substantially as claimed, wherein said transmission means sends the information in accordance with said e-mail to said mail destination in at least one form of e-mail, facsimile, telephone, and snail mail (paragraphs 0066-0068).

13. As to claim 7, Kambayashi teaches the invention substantially as claimed, including a method of e-mail delivery including the step of:

sending e-mail and transmission time information designating a time the e-mail is to be sent to a mail destination from a terminal to an e-mail delivery apparatus (figures 1, 2, block S5, paragraphs 0020, 0050, 0066);

inquiring from the e-mail delivery apparatus to the terminal whether or not the terminal desires to receive the information in accordance with the e-mail before a time specified by the transmission time information (figures 1, 2, block S6, paragraphs 0050-0051); and

sending the information in accordance with the e-mail from the e-mail delivery apparatus to the terminal when the e-mail delivery apparatus receives a response that it

desires to receive the information in accordance with the e-mail from the terminal (paragraphs 0020, 0050-0051).

14. Claims 3-4 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Kambayashi, Fujisawa**, in view of van Rijn U.S. Patent No. **6,574,604**.

15. As to claim 3, Kambayashi and Fujisawa do not explicitly teach the invention substantially as claimed; however, van Rijn teaches wherein said receiving means receives address management information of the mail destination of said e-mail and charging information; and said e-mail delivery apparatus further comprises an address management means for managing an address of the mail destination of information in accordance with said e-mail based on said address management information and a charging means for performing charging based on said charging information (abstract, figure 2, col. 4, lines 29-63, col. 8, lines 1-43). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teachings of Kambayashi, Fujisawa and van Rijn to include a receiving means receives address management information of the mail destination of said e-mail and charging information and sending e-mail based on said address management information and a charging means for performing charging based on said charging information because it would have an efficient management communications system and payment system that manage and charge client whenever accessing the message of the Internet message system.

16. As to claim 4, Kambayashi and Fujisawa do not explicitly teach the invention substantially as claimed; however, van Rijn teaches wherein said charging means performs at least one of charging processing to the transmitter of the e-mail at the time of receiving said e-mail and charging processing to the mail destination at the time of sending the information in accordance with said e-mail (abstract, figure 2, col. 4, lines 29-63, col. 8, lines 1-43). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teachings of Kambayashi, Fujisawa and van Rijn to have the same motivation as set forth in claim 3, *supra*.

17. Claim 5 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Kambayashi, Fujisawa, van Rijn**, in view of **Wheeler et al.** (hereinafter Wheeler) U.S. Publication No. **US 2002/0032623**.

18. As to claim 5, Kambayashi and van Rijn do not explicitly teach the invention substantially as claimed; however, Wheeler teaches wherein, when a notice of change of address of the mail destination of said e-mail is received, said address management means accordance with said e-mail sends the information in to the changed address (abstract, figure 8, paragraphs 0006, 0063-0076). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teachings of Kambayashi, van Rijn and Wheeler to include a notice of change of address of the mail destination of said e-mail is received, said

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address management because it would provide an efficient management system that can monitor and update sender and receiver's address.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20. Kawanaka (6,351,763), Maeda (2002/0038347), Takeda et al. (6,714,932), Masahide et al. (11-203215), Michiaki (10-283281) are recited for disclosing various information related to the claimed invention. Applicants are requested to consider these prior art references when responding to this office action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Ha Nguyen, whose telephone number is (703) 305-7447. The examiner can normally be reached Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam, can be reached at (703) 308-6662.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications.

Thu Ha Nguyen

September 17, 2004



HOSAIN ALAM
SUPERVISORY PATENT EXAMINER